

### **REMARKS**

Claims 1-54 were previously pending, of which claims 1-5, 8-9, 13-14, 16-23, 26-27, 31-32, 34-41, 44-45, 49-50, and 52-54 have been amended. Claims 6-7, 10-12, 15, 24-25, 28-30, 33, 42-43, 46-48, and 51 have been canceled. Reconsideration of presently pending claims is respectfully requested in light of the above amendments and the following remarks.

#### **Objections to Informalities**

Applicant notes with appreciation Examiner's thorough reading of and suggestions regarding the claims. Claims 1-18, 20-27, 30-45 and 48-54 were objected to for informalities. Examiner's objections have been considered and amendments have been made consistent with Examiner's recommendations. The amendments are made to clarify the claims and do not otherwise further limit the claims. Claims 15, 33 and 51 have been canceled per Examiner's suggestion. Claims 6-7, 10-12, 24-25, 28-30, 42-43, and 46-48 have been canceled by Applicant.

#### **Rejections under 35 U.S.C. § 103**

Claims 1, 3-8, 10-11, 15, 18-19, 21-26, 28-29, 33, 36-37, 39-44, 46-47, 51 and 54 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Meffert et al. (U.S. Publication No. 2002/0059144, "Meffert") in view of Cox et al. (U.S. Publication No. 2005/0044170, "Cox"). This rejection is respectfully traversed as to pending claims on the grounds that these references are defective in establishing a *prima facie* case of obviousness with respect to these claims.

##### **Independent Claim 1**

As regarding claim 1, this combination of references is improper as neither Meffert nor Cox teaches, or even suggests, the desirability of the combination as specified above and as claimed in claim 1. In this context, the MPEP further provides at § 2143.01 that "[t]he mere fact

that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

As stated by Examiner, “Meffert is silent on the capability of converting recipients’ addresses from an email format to an Internet format and converting recipients’ addresses from said Internet format to said email format” – a required element of claim1. (Office Action, pgs. 9-10). Thus, Examiner attempts to rely on Cox for the missing requirement. However, Examiner’s reliance on Cox is not proper because Meffert teaches against the use of a PGP system with an email system.

Meffert clearly teaches against the combination by stating that “Pretty Good Privacy, commonly known as ‘PGP’, is a ‘stripped-down’ version of a PKI system...”. [0007]. Meffert further teaches that PGP is not a robust PKI system meriting further consideration. [0010]. Meffert continues:

PGP can sometimes be *awkward to use* and, more importantly, is less robust when it comes to issues like digital certificate creation, management, automated key issuance and retrieval, authentication and trust. Specifically, in PGP there are *no certificates, CAs, or strong authentication*. Thus, PGP is only a *limited solution* to security issues on the Internet.

[0007], emphasis added

In addition to Meffert’s teaching against combining, Cox fails to offer any showing, suggestion, incentive or motivation for the combination. Cox teaches “a novel data storage systems and related methods”. [0003]. More specifically, Cox teaches a less expensive data storage system for large companies that is capable of processing extremely large amounts of data “without bogging down”. [0003]. Cox fails to offer any suggestion to combine the teaching of data storage methods to the integration of PGP type software with an email system.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

The courts have repeatedly held that obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination.

In the present case it is clear that the Examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 1. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

#### Independent Claim 19

As regarding claim 19, this combination of references is improper as neither Meffert nor Cox teaches, or even suggests, the desirability of the combination as specified above and as claimed in claim 19. In this context, the MPEP further provides at § 2143.01 that "[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination."

Meffert clearly teaches against the combination by stating that "Pretty Good Privacy, commonly known as 'PGP', is a 'stripped-down' version of a PKI system...". [0007]. Meffert further teaches that PGP is not a robust PKI system meriting further consideration. [0010]. Meffert continues:

PGP can sometimes be *awkward to use* and, more importantly, is less robust when it comes to issues like digital certificate creation, management, automated key issuance and retrieval, authentication

and trust. Specifically, in PGP there are *no certificates, CAs, or strong authentication*. Thus, PGP is only a *limited solution* to security issues on the Internet.

[0007], emphasis added

As stated by Examiner, claim 19 “is directed to a hardware implementation of method of claim 1 and is rejected by a similar rationale applied against claim 1 above.” (Office Action, pg. 13). As stated above, Examiner’s reliance on Cox is not proper because Meffert teaches against the use of a PGP system with an email system.

While Meffert teaches against combining, Cox fails to offer any showing, suggestion, incentive or motivation for the combination. Cox teaches “a novel data storage systems and related methods”. [0003]. More specifically, Cox teaches a less expensive data storage system for large companies that is capable of processing extremely large amounts of data “without bogging down”. [0003]. Cox fails to offer any suggestion to combine the teaching of data storage methods to the integration of PGP type software with an email system.

Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In the present case it is clear that the examiner’s combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 19. Therefore, for this mutually exclusive reason, the examiner’s burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

### Independent Claim 37

As regarding claim 37, this combination of references is improper as neither Meffert nor Cox teaches, or even suggests, the desirability of the combination as specified above and as claimed in claim 37. In this context, the MPEP further provides at § 2143.01 that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.”

Meffert clearly teaches against the combination by stating that “Pretty Good Privacy, commonly known as ‘PGP’, is a ‘stripped-down’ version of a PKI system...”. [0007]. Meffert further teaches that PGP is not a robust PKI system meriting further consideration. [0010]. Meffert continues:

PGP can sometimes be *awkward to use* and, more importantly, is less robust when it comes to issues like digital certificate creation, management, automated key issuance and retrieval, authentication and trust. Specifically, in PGP there are *no certificates, CAs, or strong authentication*. Thus, PGP is only a *limited solution* to security issues on the Internet.

[0007], emphasis added

As stated by Examiner, claim 37 “is directed to a software implementation of method of claim 1 and is rejected by a similar rationale applied against claim 1 above.” (Office Action, pg. 13). As stated above, Examiner’s reliance on Cox is not proper because Meffert teaches against the use of a PGP system with an email system.

Neither does Cox offer any showing, suggestion, incentive or motivation for the combination. Cox teaches “a novel data storage systems and related methods”. [0003]. More specifically, Cox teaches a less expensive data storage system for large companies that is capable of processing extremely large amounts of data “without bogging down”. [0003]. Cox fails to

offer any suggestion to combine the teaching of data storage methods to the integration of PGP type software with an email system.

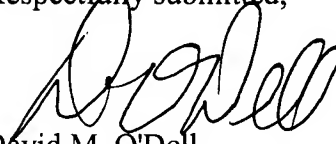
Thus, it is clear that neither patent provides any incentive or motivation supporting the desirability of the combination. Therefore, there is no basis in the art for combining the references to support a 35 U.S.C. § 103 rejection.

In the present case it is clear that the examiner's combination arises solely from hindsight based on the invention without any showing, suggestion, incentive or motivation in either reference for the combination as applied to claim 37. Therefore, for this mutually exclusive reason, the examiner's burden of factually supporting a *prima facie* case of obviousness has clearly not been met, and the rejection under 35 U.S.C. §103 should be withdrawn.

**CONCLUSION**

As a result of the foregoing, it is respectfully asserted that each of independent claims 1, 19 and 37 is in a condition for allowance. As claims 2-5, 8-9, 13-14, and 16-18 depend from and further limit claim 1, claims 20-23, 26-27, 31-32, and 34-36 depend from and further limit claim 19, and claims 38-41, 44-45, 49-50, and 52-54 depend from and further limit claim 37 respectively, these claims are also in condition for allowance. The Examiner is invited to telephone the undersigned if further assistance is necessary. Deposit account number 08-1394 can be used for any over payments or under payments.

Respectfully submitted,

  
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I hereby certify that this correspondence is being filed with the U.S. Patent and Trademark Office via EFS-Web on <u>May 8, 2007</u> .
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